

Applicant: Murphy and Reid  
Serial No.: 09/407,806  
Filed: September 28, 1999  
Page 3

### **REMARKS**

Claims 1-14 and 17-23 were pending before this communication, claims 10-12 being withdrawn from consideration due to a restriction requirement herein. By the present communication, claims 10-12 are canceled without prejudice to focus the invention on claims under prosecution in this application, and claims 14, 17, 18 and 19 are amended to define Applicants' invention with greater particularity. No new matter is added by the amendments as the new claim language is fully supported by the Specification and original claims. Applicants submit that the claim amendment does not narrow the claims in any way within the meaning of Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd., a/k/a SMC Corporation and SMC Pneumatics, Inc. 234 F.3d 558, 51 U.S.P.Q. 2d 1959 (Fed. Cir. 2000). Accordingly, claims 1-9, 13, 14, and 17-23 are currently pending.

It is respectfully submitted that the proposed amendments submitted herewith would place the claims in condition for allowance or at least in better condition for appeal; accordingly, entry of the amendments is respectfully requested.

### **Claim Objections**

Claim 18 is objected to under 37 C.F.R. 1.75(c) as allegedly "failing to further limit the subject matter of a previous claim" (Office Action, page 2). Thus, Applicants understand that the Examiner is acknowledging that the term "DNA" in claim 2 (from which claim 18 depends) includes both single stranded DNA and double stranded DNA. Based on this understanding, Applicants have amended claim 18 to recite "single stranded DNA," thus providing an additional limitation in claim 18 over those in claim 2, from which it depends. Should Applicants' understanding be in error, a telephone call from the Examiner to discuss the misunderstanding is respectfully requested. In view of the amendment to claim 18, Applicants respectfully request reconsideration and withdrawal of the objection to claim 18.

Applicant: Murphy and Reid  
Serial No.: 09/407,806  
Filed: September 28, 1999  
Page 4

### **The Rejection Under 35 U.S.C. § 112, First Paragraph**

Applicants respectfully traverse the rejection of claims 14 and 19 under 35 U.S.C. § 112, First Paragraph, for allegedly lacking an enabling disclosure for the scope claimed. Applicants disagree with the Examiner's assertion that claims 14 and 19 encompass all enzymes whose encoding nucleotide sequences are identical to SEQ ID NO:4 or are 70% to 90% identical in sequence to SEQ ID NO:4 (Office Action, pages 2-3). Claims 14 and 19 depend ultimately from claim 1, which recites isolated polynucleotides encoding an enzyme having alpha galactosidase activity. Since the dependent claims incorporate the requirements of earlier claims from which they depend, the term "enzyme" in claims 14 and 19 is already limited in scope to enzymes with alpha galactosidase activity. However, to expedite prosecution and reduce the issues, by the present communication, Applicants have amended claim 14 to replace the phrase "an enzyme" with the phrase "an alpha galactosidase." Thus, Applicants submit that the invention isolated polynucleotides, as defined by amended claims 14 and 19, meet all requirements under 35 U.S.C. § 112, First Paragraph and reconsideration and withdrawal of the rejection is respectfully requested.

Applicants further traverse the rejection of claim 17 as "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicant's disagree with the Examiner's assertion that the term "genomic DNA" in claim 17 encompasses such additional elements as regulatory, promoter and terminator sequences, since such a contorted claim construction would make the scope of dependent claim 17 broader than the scope of claim 1, from which it ultimately depends. Furthermore, Applicants respectfully submit that SEQ ID NO:4 is already inherently the same as the nucleotide sequence of a segment of genomic DNA. Thus, Applicants respectfully submit that claim 1 itself encompasses "genomic DNA."

Applicant: Murphy and Reid  
Serial No.: 09/407,806  
Filed: September 28, 1999  
Page 5

However, to expedite prosecution and reduce the issues, by the present communication, Applicants have amended claim 17 to delete "genomic DNA." Thus, Applicants submit that the invention isolated polynucleotides, as defined by amended claims 17, meet all requirements under 35 U.S.C. § 112, First Paragraph and reconsideration and withdrawal of the rejection is respectfully requested.

### **Double Patenting**

Applicants traverse the rejection of claims 1-9 and 13, 14, and 17-23 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 3-14 of U.S. Patent No. 5,958,751.

Applicants submit with this response a Terminal Disclaimer disclaiming the terminal part of any patent granted on the above-identified application that would extend beyond the expiration date of U.S. Patent No. 5,958,751. In view of the Terminal Disclaimer submitted herewith, Applicants submit that the rejection for obviousness-type double patenting is overcome. Accordingly, reconsideration and withdrawal of the rejection of claims 1-9 and 13, 14, and 17-23 as unpatentable over U.S. Patent No. 5,958,751 are respectfully requested.

In view of the above amendments and remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect respectfully is requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

Applicant: Murphy and Reid  
Serial No.: 09/407,806  
Filed: September 28, 1999  
Page 6

Please charge any additional fees, or make any credits, to Deposit Account No. 50-1355.

Date: \_\_\_\_\_

6/12/01

Respectfully submitted,

Lisa A. Haile

Lisa A. Haile, Ph.D.

Reg. No. 38,347

Attorney for Applicant

Telephone No.: (858) 677-1456

Facsimile No.: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP  
USPTO Customer Number 28213  
4365 Executive Drive, Suite 1600  
San Diego, California 92121-2189

Applicant: Murphy and Reid  
Serial No.: 09/407,806  
Filed: September 28, 1999  
Page 7

## EXHIBIT A

### Version with Markings to Show Changes Made

#### In the Claims

Please cancel claims 10-12 without prejudice.

Please amend claims 14, 17 and 18 as follows:

14. (Amended) The polynucleotide of claim 13, wherein the polynucleotide has at least 90% identity to a polynucleotide encoding an [enzyme] alpha galactosidase comprising the amino acid sequence set forth in SEQ ID NO:4.

17. (Amended) The polynucleotide of claim 2, wherein the DNA is cDNA[, genomic DNA] or synthetic DNA.

18. (Amended) The polynucleotide of claim 2, wherein the DNA is single stranded [or double stranded].

19. (Amended) The polynucleotide of claim [14] 18, wherein the single stranded DNA is a coding sequence.